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10/800,664	03/16/2004	Zechary Chang	TAIW 219	2257

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EXAMINER	
UTAMA, ROBERT J	
ART UNIT	PAPER NUMBER
3714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/800,664	CHANG ET AL.	
	Examiner	Art Unit	
	ROBERT J. UTAMA	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is a response to the amendment and arguments on: . The current status of the claims in the application are as follows: claim 1-17 are still pending. No claims have been cancelled.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Clams 1-16 are directed towards a computer program (or game) that is not recorded to any computer readable medium or other physical structure. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. While the claim 1-15 do recite a playing platform and system in the preamble of the claim; such limitation are not used in some positive manner within the main body of the claim. Furthermore, the specification does not define what a playing platform is defined as a physical structure. Lastly, a limitation in the preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Hence, the examiner takes the position that such claim language is considered to be non-statutory subject matter (see MPEP 2106.01).

3. Secondly the claim 8-13, 16 and 17 are also rejected under 35 U.S.C 101 since it is directed towards a computer implemented method that is not tied to another statutory subject

matter (such as an apparatus or a composition of matter or an article of manufacture). In order to be considered patent eligible under 35 USC 101, a claimed process must contain a sufficient tie to a machine, article of manufacture or a composition of matter. *In re Comiskey,* 84 USPQ2d 1670 (Fed. Cir. 2007). In this case, the claimed invention does not have a sufficient tie to any machine, article of manufacture or a composition of matter. While claim 8-13 and 17 do recite a computer platform in the preamble section of the claim, such step is not a sufficient tie if the computer platform is not being used in some positive manner. Also, ties that appear in the preamble are usually not sufficient unless that tie is also positively recited in the body of the claim. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claim 1-13 rejected under 35 U.S.C. 102(b) as being anticipated by Wasowicz US 6,435,877 (herinafter Wasowicz '877) and including the reference that is incorporated of Wasowicz US 6,299,452 (hereinafter Wasowicz '452) see Wasowicz '877 col 6:10-15.**

Claim 1: Wasowicz '452 provides a teaching of a playing module that provides a playing prcoess according to predetermined playing mode (see Wasowicz '452 col. 8:25-39 diagnostic tool "sound blender", "sound manipulator" and etc) and receives operation control command

from a user to execute the playing process (see Wasowicz '452 col. 10:10-20 "user input") comprising of: a playing element database that stores playing elements needed by said playing process of said playing mode (see Wasowicz '452 FIG. 2 item 62) and a playing operating unit that receives said operation control commands for playing process (see Wasowicz '452 col. 11:45-67 "select an item) and then retrieves at least one playing element from said playing element database to produce said corresponding playing process (see Wasowicz '452 col. 11:49-67 "image and items"); a user control interface that provides said operation control for the playing process and learning process (see Wasowicz '452 col. 10:10-20 "keyboard") and an event triggering module requesting corresponding learning process according to a triggered event produced during the playing process (see FIG 27 596 and 598 col 17:35-50).

Wasowicz '877 provides a teaching of a learning module used to provide the learning process according to predetermined learning mode and receives the operation control to execute the learning process that comprises of a language element database (see Wasowicz '877 FIG. 3 item 110 and col. 7:28-50 "pesky parrot", "calling all detection"); a learning executing unit, according to said triggered event, retrieving at least one language element to produce said corresponding learning process and receiving said operation control to said learning process (see Wasowicz '877 col. 17:45-50 "training module diagnosis") and a learning adjustment unit, used to adjust to said playing mode and learning mode according to learning and evaluation control (see Wasowicz '877 FIG. 15 item 250 and 264 and Wasowicz '452 FIG 27 col. 594 and 596).

Claim 2 and 13: Wasowicz provides a teaching of combined progressive learning system having a control system where the user control interface is further employed for providing said playing mode (see Wasowicz '452 col. 10:10-20) and learning mode (see Wasowicz '877 col. 15-25-30)

Claim 4: Wasowicz provides a teaching of language learning system wherein the learning adjustment further comprises of learning recording and evaluating during said learning process (Wasowicz '877 col. 14:65-col. 15:7).

Claim 5 and 12: Wasowicz provides a teaching of language learning system wherein the learning adjustment further comprises for storing said learning record when said playing process and said learning process are terminated (Wasowicz '877 see col. 7:5-20 and Wasowicz '452 col. 7:35-45).

Claim 6 and 9: Wasowicz provides a teaching of language learning system wherein said learning mode is selected from the group consisting of alphabets and words (see Wasowicz '877 FIG. 5 and 6).

Claim 7 and 10: Wasowicz provides a teaching where the language elements are one selected from the group consisting of sound (see Wasowicz '877 col. 3:9-15) and image (Wasowicz '877 FIG 23 item 440).

Claim 8 and 17: Wasowicz computer game combined progressive language learning method, which comprises the step of: activating game and determine a playing mode (see Wasowicz '452 col. 8:25-39 diagnostic tool "sound blender", "sound manipulator" and etc) and a learning mode (see Wasowicz '877 FIG. 3 item 110 and col. 7:28-50 "pesky parrot", "calling all detection"); executing game initialization and starting a playing progress according to said playing module (see Wasowicz '452 col. 11:55-65); activating said learning mode and executing a corresponding learning progress as a triggered event occur (see Wasowicz '452 col. 17:45-50 "user selecting training module"); recording and evaluating learning records in said learning process and store the learning records (see Wasowicz '877 col. 7:5-13) and adjusting said learning module and said playing mode instantaneously according to said learning records (see Wasowicz '877 col. 6:35-45).

Claim 15: The Wasowicz reference provides a teaching of a user control interface that comprises of a plurality of a manually operable keys (see Wasowicz '452 col. 10:10-20 keyboard).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claim 3, 11, 14 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Wasowicz US 6,435,877 (herinafter Wasowicz '877) and including the reference that is incorporated Wasowicz US 6,299,452 (hereinafter Wasowicz '452) see Wasowicz '877 col 6:10-15 and in view of Sorensen US 5,827,071.**

Claim 3 and 11: While the Wasowicz reference provides a teaching of having an active triggered events (see Wasowicz '452 col. 17:45-50 "user selecting training module"); it does not provide a teaching of a passively triggered events. However, the Sorensen reference provides a teaching of a passively triggered event (see Sorensen col. 3:27-40). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of having a passively

triggered event as taught by Sorensen, in order to expose the user with a new learning material in a non-intrusive manner (see Sorensen Abstract)

Claim 14 and 16: While the Wasowicz reference provides a teaching of a triggered event in repose to events that occurs during the playing mode as a result of the operational control commands from the user (see Wasowicz '452 col. 17:45-50 "user selecting training module"); it does not provide a teaching of an event triggering module produces triggered events randomly. However, the Sorensen reference provides a teaching of an event triggering module produces triggered events randomly (see Sorensen col. 3:27-40 and col. 6:25-35). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of having trigger event that produces triggered events randomly as taught by Sorensen, in order to expose the user with a new learning material in a non-intrusive manner(see Sorensen Abstract).

Response to Arguments

9. The objection to the drawing and the claim raised in the previous office has been withdrawn due to the appropriate correction.

10. With respect to applicant's argument on claim 1-17 for the rejection under 35 U.S.C 101 as being directed to a non-statutory subject matter. The applicant argues that the inclusion of the " ... actuated in a playing platform" would make claim 1-17 35 U.S.C 101 compliant. The examiner respectfully disagrees. While the claim 1-15 do recite a playing platform and system in the preamble of the claim; such limitation are not used in some positive manner within the main body of the claim. Furthermore, the specification does not support that the playing platform of FIG 1 item 100 is actually a physical structure. It is not clear from the specification what a playing platform is defined to be. Lastly, limitation in the preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to

stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

11. With respect to applicant's argument with regards of the Wasowicz reference lacking a separate playing and learning module. Newly cited recitation of the Wasowicz correspond to a separate playing and learning module.

12. With respect to applicant's argument on the limitation of "triggered events requesting a learning event produced during the playing process." The examiner respectfully disagrees. In this particular case the examiner interprets the term trigger event as any events that cause another event to occur. In this case, the user is directed to a learning element where the user can be trained in a certain aspect of linguistic studies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. UTAMA whose telephone number is (571)272-1676. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. U./
Examiner, Art Unit 3714

/XUAN M. THAI/
Supervisory Patent Examiner, Art Unit 3714